

REMARKS/ARGUMENTS

Status of the Claims

In the Office Action mailed January 19, 2005 claims 1, 5-17 and 21 are pending. Claims 1, 5-17, and 21 stand rejected. This rejection is respectfully traversed. Claims 12 and 13 have been amended. No new matter has been added. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Claim Rejections 35 U.S.C. §112

Examiner rejected claims 13-16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Without conceding the propriety of the rejection, but rather to further prosecution of this case, Applicants amended claim 13 which obviates the Examiner's rejection. In light of the amendment to the claims, Applicants hereby respectfully request that the rejection to these claims be withdrawn and the claims allowed.

Claim Rejections 35 U.S.C. §103(a)

Claims 1, 12-14 and 17

Examiner rejected claims 1, 12-14 and 17 under 35 U.S.C. §103(a) as being unpatentable over USP 5,916,286 to Seashore, *et al.*, (hereinafter "Seashore"), in view of USP 5,965,658 to McMahon. Without conceding the propriety of the rejection, claims 12 and 13 have been

amended. Support for the amendment may be found throughout the specification and the figures.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. In light of the following arguments, the combined references do not teach or suggest all of the claim limitations of the present invention. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970).

Claim 1

Seashore is directed to a portable automotive diagnostic tool for receiving information from an automotive computer of a vehicle. (Abstract). Information stored by the automotive computer is downloaded by the portable automotive diagnostic tool, stored in the SRAM and is displayed on the LCD to determine the automobile status. (Col. 3, lines 13-17). “A second group of keys on keypad 22 are the navigation keys for controlling the information displayed on display 23. The UP button scrolls or moves up to display data in a stream of data. The DOWN button scrolls or moves down to display data in the stream of data. The NEXT button causes the next data in the data stream to be displayed on display 23. The BACK button moves to display

the previous data in the stream of data. The CONFIRM/ENTER button selects an option or confirms an option.” (Col. 6, lines 37-45). Thus, Seashore through a user’s input can scroll through data as it is displayed and cannot change the placement of data and lacks the capability wherein, “output data is displayed on said graphical user interface as a list . . . wherein the location of a diagnostic value in the list of diagnostic values is selectable by a user,” and “wherein said input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list,” as recited in claim 1.

McMahon does not cure the deficiencies of Seashore because McMahon is directed to a data collection system that includes a hand held data collector for connecting to a computer processing station, which has software that provides a grouping of machines from which the data is to be collected. (Abstract). McMahon is directed to allowing a user in the field to create the desired sequence with the flexibility of changing the sequence of the group of machines to insure a sufficient collection of field data by the data collector. (Col. 5, lines 54-57). Furthermore, the data collector gathers data and the results, or output, are sent back to the computer processing station for examination. (Col. 1, lines 22-25; Col 4, lines 22-30). Thus, McMahon only discloses the ability to change the sequence of the list of machines to collect data and does not provide for the ability to change the sequence of the gathered data of the measurements, or output, from the machines. Any data collected would then be reviewed on the computer instead of the data collector, thus there is no motivation to combine the McMahon reference with Seashore.

Thus, Seashore and McMahon separately or in combination fail to teach or suggest, *inter alia*, “output data is displayed on said graphical user interface as a list . . . wherein the location of a diagnostic value in the list of diagnostic values is selectable by a user,” and “wherein said input

device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list,” as recited in claim 1.

Applicants also respectfully point to the first prong of the test, which states that there must be some suggestion or motivation to modify the references. At the very least, the cited references does not suggest or motivate one to alter the Seashore reference to arrive at all aspects of claim 1 especially “output data is displayed on said graphical user interface as a list . . . wherein the location of a diagnostic value in the list of diagnostic values is selectable by a user,” and “wherein said input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list.” Furthermore, even if it is proper to combine McMahon with Seashore, all the elements of the claims are not present and thus, the Examiner has not established a *prima facie* case of obviousness.

Claims 5-11 depend directly or indirectly from independent claim 1 and are believed to be patentable at least by reason of their dependency. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

Claim 12

For the reasons discussed previously, it is respectfully submitted that Seashore and McMahon, separately or in combination fail to teach or suggest, *inter alia*, displaying, “a list of diagnostic values as output data received from sensors in a vehicle,” and “changing a placement location of the first selected diagnostic value within an order of the list,” as recited in claim 12.

Claims 13-16 and 21 depend directly or indirectly from independent claim 12 and are believed to be patentable at least by reason of their dependency. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

Claim 17

For the reasons discussed previously, it is respectfully submitted that Seashore and McMahon separately or in combination fail to teach or suggest, *inter alia*, “output data is displayed on said graphical user interface means as a list . . . wherein the location of a diagnostic value in the list of diagnostic values is selectable by a user,” and “wherein said input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list,” as recited in claim 17.

Since, each and every element of the present invention is not taught by the prior art, Seashore, alone or in combination with McMahon, can not teach, show or suggest the present invention, as recited in these claims. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 5-7, 10 and 21

Claims 5-7, 10 and 21 stand rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of McMahon and in further view of Borsuk (U.S. Patent No. 5,475,399). Claims 5-7, and 10 depend directly or indirectly from claim 1 and claim 21 indirectly depends from claim 12. Because claims 1 and 12 are believed to be in condition for allowance, as shown above, claims 5-7, 10 and 21 are also believed to be in condition for allowance at least by reason of their dependency. Withdrawal of the rejection is respectfully requested.

Claims 8 and 9

Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of McMahon in further view of Borsuk and in further view of Danielson, *et al.* (U.S. Patent

No. 5,895,906). Because claims 8 and 9 depend directly or indirectly from claim 1, which is believed to be in condition for allowance, as shown above, these claims are also believed to be in condition for allowance at least by reason of their dependency. Withdrawal of the rejection is respectfully requested.

Claim 11

Claim 11 was rejected under 35 U.S.C. §103(a) as being obvious over Seashore in view of McMahon in further view of Borsuk and in further view of Herrod, *et al.* (U.S. Patent No. 6,405,049). Because claim 11 depends indirectly from claim 1, which is believed to be in condition for allowance, as shown above, this claim is also believed to be in condition for allowance at least by reason of their dependency. Withdrawal of the rejection is respectfully requested.

Claims 15 and 16

Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as being obvious over Seashore and McMahon in further view of Gurne, *et al.* (U.S. Patent No. 5,541,840). Because claims 15 and 16 depend directly or indirectly from claim 12, which is believed to be in condition for allowance, as shown above, these claims are also believed to be in condition for allowance at least by reason of their dependency. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at 202-861-1746 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87355.1623.

Respectfully submitted,

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